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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,994

11/26/2003

Tomohiro Miyashita

XA-9999

6540

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7590

06/08/2006

MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

PRITCHETT, JOSHUA L

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,994

Applicant(s)

MIYASHITA, TOMOHIRO

Examiner

Joshua L. Pritchett

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8, 10-18, 20, 21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8, 10, 11, 20, 21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Request for Continued Examination filed May 15, 2006 and Amendment filed April 12, 2006. Claims 3, 5, 7 and 20 have been amended, claims 23 and 24 have been added and claims 19 and 22 have been cancelled as requested by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 10, 11, 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki (US 6,128,128) in view of Kusaka (US 2001/0040723).

Regarding claims 3 and 5, Otaki teaches a microscope system (Fig. 1) comprising an objective lens (L1) and an intermediate magnification varying part disposed just after the image side of the objective lens (L2-L8; Figs. 6 and 8). Otaki teaches the intermediate magnification varying part includes a lens group having a positive refractive power and a lens group having a negative refractive power and in high magnification the lens group having a positive refractive power disposed just after the image side of the objective lens (Fig. 6; magnification 10x;

Art Unit: 2872

objective L1, positive power L2; negative power L3 and L4 cemented together) while in a low magnification the lens group having a negative refractive power is disposed just after the image side of the objective lens (Fig. 8; magnification 2x; objective L1; positive power L8; negative power L2). Otaki teaches the intermediate magnification varying part is constructed in such a way that its optical system is rotatably relative to an optical axis of the objective lens with an axis substantially orthogonal to the optical axis of the objective lens being a rotation axis (Figs. 1 and 2). Fig. 1 shows that the optical axis of the light beam through the microscope bends at several locations providing several different optical axes. Fig. 2 shows the rotation axis (20 Ax), which in the broadest reasonable interpretation of the phrase “substantially orthogonal” meets the claim limitations for one of the optical axes shown in Fig. 1. Otaki lacks reference to the intermediate magnification part rotatable relative to the objective. Kusaka teaches an intermediate magnification part (12) rotatable relative to the objective (Figs. 12A-B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Otaki invention include the rotatable intermediate magnification part of Kusaka for the purpose of centering the image to the eyepiece of the microscope to allow easier viewing of the image by an observer.

Regarding claims 4, 6, 10 and 11, Otaki teaches the microscope optical system is provided with a connecting portion (20) on the image side of the intermediate magnification varying part and the microscope optical system can be connected with a body of a microscope by means of the connecting portion (Fig. 1).

Regarding claims 23 and 24, Otaki teaches an optical axis of the intermediate magnification varying part is aligned with the optical axis of the objective lens (Figs. 1, 6 and 8)

Art Unit: 2872

and the intermediate magnification varying part is construed to be rotated by 180 degrees about the rotation axis at a point on the optical axis (Fig. 2) of the intermediate magnification varying part to select one of the high magnification variation state and the low magnification variation state (col. 4 lines 56-63).

Claims 7, 8, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki (US 6,128,128) in view of Kusaka (US 2001/0040723) as applied to claims 3 and 5 above further in view of Yonezawa (US 6,320,702).

Otaki in combination with Kusaka teaches the invention as claimed but lacks reference to the claimed magnification state ratios. Yonezawa teaches moving lenses within the intermediate magnification varying part along the optical axis to change the magnification (abstract). After combining the teachings of both Otaki and Yonezawa one of ordinary skill in the art would be able to set the magnification to a wide variety of settings, which depending on the preference of the operator would fall within the claimed magnification ranges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Otaki invention include the movable lenses of Yonezawa in the intermediate magnification varying part for the purpose of allowing both rough and fine tuning adjustments to the magnification state of the microscope to allow observation of large areas and quickly be able to zoom in or out of smaller areas within the large area of observation.

Response to Arguments

Applicant's arguments, see Amendment, filed April 12, 2006, with respect to 112 1st rejection have been fully considered and are persuasive. The 112 1st rejection of claims 3-8, 10, 11, 20 and 21 has been withdrawn. Applicant properly pointed out the portion of the specification that provides support for the claimed limitations.

Applicant's arguments filed April 12, 2006 have been fully considered but they are not persuasive.

Applicant argues that Otaki and Kusaka are not combinable because they are different systems. Both the Otaki and Kusaka references are directed to microscopes with variable magnification achieved by switching lenses as shown in Otaki (abstract) and Kusaka (para. 0008). The references are similar enough that one of ordinary skill in the art would recognize the teachings of one reference may be combined with or into the teachings of the other reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLP 



DREW A. DUNN
SUPERVISORY PATENT EXAMINER